

REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on March 9, 2007, the Examiner rejected claims 1-16 and 18-23 under 35 U.S.C. § 103(a) as being unpatentable: claims 1-16 and 18-23 over U.S. Patent No. 5,295,064 to Malec (hereinafter “Malec”) in view of U.S. Patent No. 5,264,822 to Vogelmann (hereinafter “Vogelmann”).

Applicants respectfully traverse.

Rejections under 35 U.S.C. § 1112:

Claim 1 has been amended to appropriately clarify the relationship between the transmitter and transceiver. Accordingly, Applicants respectfully requests that the Section 112 rejection be withdrawn at this time.

Rejections under 35 U.S.C. § 103(a):

In the Office action, the Examiner rejected all claims citing at least the combination of Malec and Vogelmann. The standard for a Section 103 rejection is set forth in M.P.E.P 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

Applicants respectfully submit that the references cited by the Examiner do not teach or suggest all the limitations claimed in the claim set provided herein. Applicants also respectfully submit that there is no suggestion or motivation to combine the references in the manner suggested by

the Examiner, and that one of skill in the art would not reasonably expect success in combining the references in the manner provided.

The Cited Art Fails to Teach All Claim Limitations

Amended independent claim 1 now provides for an electronic shopping cart display system comprising: a display unit having a display screen attached to a shopping cart for displaying information; one or more transceiver units for sending information to the display unit, said transceiver units located proximate to promoted items, wherein the information includes product-specific promotions ; a transmitter in direct electronic communication with the transceiver unit, for sending information to the transceiver; an audible alert component on the display unit for signaling receipt of information from the transceiver unit; and a computer for operating the interaction between the display unit, the transceiver units, and the transmitter in direct electronic communication with the transmitter unit and in indirect electronic communication with the transceiver unit through the transmitter. These combinations of elements are not disclosed in the cited references.

The “Trigger Transmitters” taught in Malec transmit simple positional information which is used to trigger promotional information stored on the cart-mounted electronics. Malec, Column 8, Lines 52-56. By explicitly storing all promotional and/or other product-related information on the cart-mounted electronics, Malec clearly teaches away from the transmission of promotional product specific from the transceiver units.

Malec teaches a shopping cart display system but does not disclose transceiver units in direct electronic communication with a transmitter and a computer that operates the interactions between the various units. Claim 1 now requires that the transceivers be in direct electronic communication with a transmitter sending information from the controlling computer and further

requires that the transceivers send product-specific promotions to the display units, and requires that a computer for operating the interaction between the display unit, the transceiver units, and the transmitter be in direct electronic communication with the transmitter unit and in indirect electronic communication with the transceiver unit through the transmitter. These limitations are not taught or suggested by Malec.

The trigger transmitters of Malec serve a completely different function from the transceivers claimed. Malec's trigger transmitters do not transmit any product-specific information for the user, but merely transmit location information; the display then searches in its memory for messages related to that location information for display. (Col 8 lines 41-60) Thus, the trigger transmitters only serve as location beacons serving as signposts to tell the shoppers "You are here." (Col 2 lines 29-36) Because the trigger transmitters only transmit location information which is not subject to changes, they do not need to receive any additional information to function, and thus do not have receivers and are not in direct communication with the centralized computer system or with any other transmitters.

In contrast, the transceivers claimed serve a function of transmitting product-specific promotions and advertisements and/or other product specific information for display on the display unit. This information is more complex and as described in the specification as filed is subject to change. The claimed transceivers are designed to be able to receive additional information to update the product-specific information to be transmitted, and are thus in communication with the controlling computer and transmitter. The trigger transmitters of Malec fail to achieve the same result as the claimed transceivers because they fail to allow for updated information to be transmitted from the control computer to the transceiver units and then from the transceiver units to the display units. This result is only achieved by Applicants' claimed

invention because the transceiver units are in direct electronic communication with the computer through the transmitter as claimed.

The Volgelman device teaches away from the present invention by disclosing a simple system for broadcasting audio messages to shopping carts moving through a plurality of pre-defined spatial zones in a store. Abstract. Volgelman selectively places transmitter's in particular geographic areas in a store. Each transmitter includes a single audio message and a transmitting means for sending a carrier signal over a predefined spatial zone. As a cart enters a zone the recorded message is broadcast to the cart while in the transmission zone. Volgelman, Column 3, lines 21-50. By storing only one prerecorded audio message, and by broadcasting the same non-interactive message to each cart that enters a zone Volgelman fails to teach the limitations found in the presently amended claim set.

Replacing the transmitter of Malec with the transceiver of Volgelman as suggested by the Examiner would not arrive at the claimed invention, but would merely replace a device only capable of transmitting with one capable of transmitting and receiving. With that teaching replaced, Malec would still teach a transceiver that transmits location information that the SCD interprets to choose which previously-stored message to display. Malec does not teach any communication between the individual carts and the centrally-based store transmitter/transceiver.

Malec in view of Volgelman does not teach "a computer for operating the interaction between the plurality of display units, the plurality of transceiver units, and the transmitter." Rather, Malec discloses a computer that controls the transmission of screen graphics to the shopping cart displays, but that computer does not interact with the transmitters. Likewise, Volgelman disclose an onboard speaker capable of vocalizing the audio signal being broadcast in the region of the cart. Volgelman does not disclose a computer that interacts with the

transmitters. Accordingly, Applicant respectfully requests that the rejection of claim 1 be withdrawn.

Lack of Motivation to Combine References

Combining Volgelman's simple analog audio receiver with Malec computer destroys Malec's invention. Accordingly, the combination of Malec and Volgelman is inappropriate. Even if either Malec or Volgelman is misinterpreted to teach all the claim limitations, Applicants respectfully submit that there is no motivation to combine Malec and Volgelman to arrive at the claimed invention, and that one of skill in the art would not expect success in doing so.

Applicants respectfully submit that "[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *In re John R. Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). Any such suggestion must be "found in the prior art, and not based on applicant's disclosure." *In re Vaeck*, 947 F.2d at 493. Indeed, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990). A "clear and particular" showing of the suggestion to combine is required to support an obviousness rejection under Section 103. MPEP § 2142.

In essence, Applicants urge that the proposed combination of the listed references is not a product of a suggestion contained within them, but a product of inappropriate hindsight analysis. "Hindsight reconstruction" cannot be used "to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *Ecolchem, Inc. v. S. California Edison Co.*, 227 F.3d 1361, 1371 (Fed. Cir. 2000). Rather, "the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation

to combine the prior art references.” *Id.* “Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability-the essence of hindsight.” *Id.*

In light of the absence of any suggestion or motivation to combine the above-referenced prior art, the mere fact that such prior art could be combined in a matter suggested by the Examiner does not render the presently-claimed invention obvious.

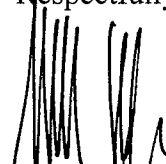
Therefore Applicants respectfully submit that the cited references, alone or in combination, fail to teach all claim limitations of independent claim 1, that one of skill in the art would not be motivated to combine the references as indicated, and that one of skill in the art would not expect success in doing so to arrive at the claimed invention. For all these reasons, Applicants respectfully submit that claim 1 is not made obvious by the cited combination of references and therefore respectfully request removal of the rejection. Claims 2-23 depend from claim 1 and are allowable for at least the same reasons. Applicants therefore respectfully request removal of all remaining rejections.

CONCLUSION

Applicants submit that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicants request favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 6 day of June, 2007.

Respectfully submitted,



Michael E. Krieger
Attorney for Applicants
Registration No.: 35,232

KIRTON & McCONKIE
1800 Eagle Gate Tower
60 East South Temple
Salt Lake City, Utah 84111
Telephone: (801) 321-4814
Facsimile: (801) 321-4893